

## REMARKS

Claims 1 - 11 are pending in the present Application. Claims 3 and 9 have been amended, leaving Claims 1 - 11 for consideration upon entry of the present Amendment. The Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

### Amended Claims

Claims 3 and 9 have been amended to better define the invention. The amendment was not made to overcome any of the cited references.

### Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 3 and 9 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In making the rejection, the Examiner has stated that

a substantially different predetermined one of the plurality of curing environments renders the claim indefinite because it is not clear how one curing environment could be different

(Office Action dated 08/09/2004, page 2).

Applicant has amended the claim to show that successive curing environments are different from one another, thereby rendering the rejection moot. Applicants respectfully request a withdrawal of the rejection and an allowance of the claims.

### Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1 - 11 stand rejected under 35 U.S.C. § 103(a), as being allegedly unpatentable over U. S. Patent No. 6,004,617 to Schultz et al. in view of U. S. Patent No. 5,200,230 to Poullos.

(Office Action dated 08/09/2004, page 2) In making the rejection, the Examiner has stated that

[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a scanning mirror system having a mirrored surface positionable relative to an incoming radiation beam for delivering a laser beam to target regions on the

substrate in Schultz et al since Poullos et al teach that a laser beam can be delivered to target regions on the substrate using a scanning mirror system having a mirrored surface positionable relative to an incoming radiation beam

(Office Action dated 08/09/2004, page 3). Applicants respectfully disagree.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness, i.e., that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

The present application is directed to a method for creating a combinatorial coating library, comprising selectively depositing at least one of a plurality of materials suitable for forming at least one coating layer on a surface of one or more substrates; selectively applying at least one of a plurality of curing environments to each of a plurality of regions associated with the at least one coating layer using a scanning mirror system having a mirrored surface positionable relative to an incoming radiation beam, wherein the mirrored surface is positionable to direct the incoming radiation beam to a selected one of the plurality of regions associated with the coating layer; and wherein the combinatorial coating library comprises a predetermined combination of at least one of the plurality of materials and at least one of the plurality of curing environments associated with each of the plurality of regions.

Schultz teaches methods and apparatus for the preparation and use of a substrate having an array of diverse materials in predefined regions thereon. (see Abstract) Schultz teaches that the properties can be measured using scanning Raman spectroscopy; scanning NMR spectroscopy; scanning probe spectroscopy including, for example, surface potentialometry, tunneling current, atomic force, acoustic microscopy, shearing-stress

microscopy, ultra fast photo excitation, electrostatic force microscope, tunneling induced photo emission microscope, magnetic force microscope, microwave field-induced surface harmonic generation microscope, nonlinear alternating-current tunneling microscopy, near-field scanning optical microscopy, inelastic electron tunneling spectrometer, etc.; optical microscopy in different wavelengths; scanning optical ellipsometry (for measuring dielectric constant and multilayer film thickness); scanning Eddy-current microscope; electron (diffraction) microscope. (Col. 29, line 36 – 49) As admitted by the Examiner, Schultz does not teach the use of a mirrored surface to direct incoming radiation. (Office Action dated 08/09/2004, page 3)

Poulios teaches process and apparatus for applying a fluorocarbon coating or film to a metal or other material surface of a substrate, and particularly for applying such coating to the hull of a ship, or to other objects to be submerged in fresh or saltwater, to protect their surfaces from corrosion, and/or from fouling by marine organisms, and to improve the aqueous slip of a vessel during the period the object will be exposed to either aqueous, atmospheric, or other environments; and to protect virtually any substrate surface from virtually any environmental or man-made hazard. (see Abstract) This process utilizes a laser that generates an infrared laser beam, such as, but not limited to a carbon derived gas type laser, to assist in the preparation for and attachment of a film or coating to a prepared substrate surface. (see Abstract) Poulios teaches the use of scanner mirror. (see Figure 1)

While Poulios teaches the use of a mirror, it is submitted that one of ordinary skill in the art would have no motivation to combine Schultz with Poulios, since Poulios is from a field of non-analogous art. The current application is directed to a method for creating a combinatorial coating library. While Poulios deals with coatings, it is directed to manufacturing underwater coatings in sea-going vessels. One of ordinary skill in the art desirous of creating a combinatorial coating library would not search for a reference directed to underwater coatings on the hull of a ship, or to other objects to be submerged in fresh or saltwater, to protect their surfaces from corrosion, and/or from fouling by marine organisms.

In this regard the courts have stated “[f]or the purposes of evaluating obviousness of claimed subject matter, the particular references relied upon must constitute “analogous art”. *In re Clay*, 966 F.2d 656, 659, 23 U.S.P.Q.2d 1058, 1060-61 (Fed. Cir. 1992). The art must

be from the same field of endeavor, or be reasonably pertinent to the particular problem with which the inventor is involved. *Id.*

Additionally, there is no teaching either implicit or explicit in Schultz that discloses the advantages of using a mirror for purposes of directing radiation. Similarly, one of ordinary skill in the art upon reading Poullos would not find any teachings directed at a method for creating a combinatorial library. Thus one of ordinary skill in the art upon reading Shultz and Poullos would not have found any teachings that would provide the motivation to combine them. It is therefore submitted that the Examiner has used impermissible hindsight in combining Schultz with Poullos, which is not the standard prescribed by the courts. In this regard, the courts have held that "[o]bviousness cannot be established by hindsight combination to produce the claimed invention." *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed.Cir.1991). It is the prior art itself, and not the applicant's achievement, that must establish the obviousness of the combination. *Id.*

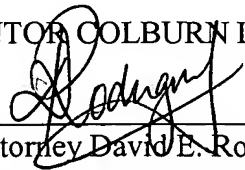
In view of the fact that there is no motivation to combine references in the manner combined by the Examiner, Applicants respectfully request a withdrawal of the rejection under 35 U.S.C. § 103 over Schultz in view of Poullos and an allowance of the claims.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance are requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,

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